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IN THE

Supreme Court of the United States

October Term, 1956

No. 934 85

GUSTAV H. BOBERTZ, JR., *Petitioner,*

vs.

GENERAL MOTORS CORPORATION, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Gustav H. Bobertz, Jr., plaintiff-appellant in the courts below, prays that a Writ of Certiorari issue to review the decision of the United States Court of Appeals for the Sixth Circuit, entered on December 14, 1955, and affirming the Order of the United States District Court for the Eastern District of Michigan, entered on August 20, 1954.

The Order of the District Court denied plaintiff-petitioner a trial and declared by way of summary judgment, over plaintiff's opposing affidavits and one month in advance of the adjourned date of the hearing on defendant's motion for summary judgment, that plaintiff-petitioner's patent on advertising display device is invalid for lack of invention in view of the prior art and is not infringed.

CITATIONS TO OPINIONS BELOW

The opinion of the United States Court of Appeals for the Sixth Circuit is reported in 228 Fed. 2nd 94, copy appended beginning at page 12a.

The Order and opinion of the United States District Court for the Eastern District of Michigan is reported in 126 Fed. Supp. 780, copy appended beginning at page 1a.

JURISDICTION

The jurisdiction of this Court is invoked under the provision of 28 U.S.C., Section 1254(1) and Section 2101(c).

The decision of the Circuit Court of Appeals was entered on December 14, 1955. On application of the petitioner made under the provisions of the Rule 22 (4) of this Court, the time to file petition for writ of certiorari was extended by the Order of this Court dated February 29, 1956, to and including May 12, 1956. Respondent was duly notified of the extension.

QUESTIONS PRESENTED

1. Was plaintiff-petitioner deprived of procedural due process by the action of the District Court in invalidating plaintiff-petitioner's patent, as lacking invention over the prior art, by a summary judgment

made upon examination of the prior art and of the pre-trial discovery record in chambers and denying plaintiff-petitioner a trial to present testimony on controverted questions of fact?

2. Was the Court of Appeals correct in approving the action of the District Court in that Court's finding, upon consideration of the prior art and discovery record in chambers, that the invention disclosed by the petitioner's patent was simple, obvious and, therefore, unpatentable as measured by the high standard of invention established by this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, and yet deny petitioner a trial to present his proofs to disprove the charge of obviousness and invalidity, particularly where petitioner sought to present evidence showing:

(a) that the problem solved by the patented solution was of long standing, and one which those skilled in the art failed to solve after many attempts;

(b) that constructions of the prior art relied on as anticipation of the patented invention were wholly inoperative for the purposes of the invention;

(c) that patentee's solution produced new and unexpected results, was incomparably superior to anything theretofore known in that field, and that these facts were admitted even by the defendant itself in the most emphatic terms in operating instructions to its dealers;

(d) that the patented and the accused devices did not operate in the manner pressed on the court by the defendant;

(e) that the mode of operation and the actual advantages of the patented device were different

from what defendant said and that resulting from a complicated phenomenon of physics, they were not comprehensible from the record.

3. On defendant's motion for summary judgment, was the District Court justified in assuming, as a jurisdictional prerequisite to its power to grant summary judgment, that there was no dispute as to any material facts, where plaintiff-petitioner's assertions in his answer to the motion and in the opposing affidavits presented by him were to the effect that the allegations of fact contained in supporting affidavits of defendant's employees were evasive and incorrect, that defendant's exhibits were improper and clouded the nature of the invention, its actual operation and advantages as well as construction of the accused device, and that proper exhibits were necessary for the Court's understanding of the invention and as part of plaintiff's proofs on the issues of both validity and infringement?

4. Is the decision of the Court of Appeals for the Sixth Circuit, appealed from, in conflict with the decision of the Circuit Court of Appeals for the Ninth Circuit in *Hycon Mfg. Co.* v. *H. Koch & Sons*, 1955, 219 Fed. 2nd 353?

STATEMENT

This is a suit commenced by the petitioner on April 27, 1950, in Detroit, Michigan, under the patent laws of the United States for infringement by the respondent of petitioner's patent No. 1,911,600, issued May 30, 1933.

The patent, which expired after the suit was brought, relates to an advertising display device for automobile

showrooms, invented and developed at a high cost to themselves by the petitioner and his co-inventor La-Fontaine, then in partnership as designers and manufacturers of advertising displays for the automobile industry. The device made it possible to set up automobile showroom displays, with the displayed automobile having the major portion of its mechanical *interior*, particularly the engine, *exposed* and *open to view* for close examination of an observer standing next to the automobile, while to an observer standing at some distance away, the same automobile appeared with its *interior invisible* and in full beauty of its exterior artistic design, with its exterior surfaces appearing unchanged and uninterrupted by any holes or gaps.

Such operation of the display was attained by substituting on the displayed automobile, and for the purposes of display only, its entire steel engine hood with a highly polished shell of transparent plastic, having configuration of its surfaces as in the steel hood and certain constructional features as disclosed in the patent. Because of the operation of certain laws of physics, such shell created the optical effect described above, and produced a remarkably illustrious display, invariably attracting large crowds.

The former practice of keeping the engine hood on a displayed automobile raised all the way up to expose the engine to view was greatly objectionable as spoiling the artistic appearance of the displayed automobile and also as causing accidents to children who might get their hands into the fan. Cutting holes and providing windows in the conventional steel hood was equally objectionable as changing and spoiling the appearance of the automobile, and was unacceptable for showroom purposes.

The results of the patented construction, while explainable by physicists as a matter of hindsight, were wholly unexpected and a great surprise to those skilled in the art. The patented solution of the petitioner was immediately accepted by the industry, and the patented all-plastic shells designed for displaying various makes and models of automobiles were sold by the petitioner to automobile dealers all over the country, and they were purchased even by the defendant itself. An immediate attempt of infringement was stopped by a court action.

In planning its 1949 national advertising campaign for Oldsmobile automobiles, the top management of the defendant received advice from its advertising agency, D. P. Brothers & Co., which knew of plaintiff's device, that the solution of problems with which the management was most seriously concerned but for which they saw no solution lay in basing all of its displays on the use of the all-plastic shell or engine hood. The defendant accepted this suggestion, organized the manufacturing, and used a large number of the devices to the total exclusion of the plaintiff. The defendant found that plaintiff's device was a real sensation in the showroom.

The infringement was organized as a project controlled directly by the defendant but in the name and appearance of a "sales company". The actual manufacturing was done out of the state, and the "sales company" was quietly dissolved after the acts of infringement were completed, its directors going out of the state after the notice of infringement was served.

Such organization of the infringing project made it possible for the defendant to claim to be merely an in-

nocent purchaser of a few accused hoods, and say that plaintiff should sue the "sales company" or each of the 5000 individual dealers all over the country who had actually used the accused display hoods.

The defendant for nearly four (4) years resisted discovery requests as to its contractual relationship with the "sales company" as well as requests to discover evidence material to validity and infringement, and the litigation turned into a long drawn-out, most difficult procedure exhausting for the plaintiff-inventor. Although the vital evidence did not reach the District Court, the record of the case, filled with motions and briefs on various collateral issues, became very voluminous (Pl. R. 69a, line 19).

Plaintiff-petitioner finally forced defendant to admit that it was the principal in the acts of infringement, and secured some evidence including defendant's own admissions which were to be part of plaintiff's proofs at the trial (Pl. R. 65a-66a).

Plaintiff-petitioner moved for leave to file an amended complaint (Pl. R. 40a-41a) to aver new facts that had come into his possession and to make the action one at law for damages only. Defendant immediately countered with a motion for summary judgment, presenting some physical exhibits and three (3) supporting affidavits, all from defendant's own employees. Allegations of these affidavits were denied by the opposing affidavits of plaintiff-petitioner (Pl. R. 52a-54a) and of his expert Tjaarda, an automobile designer and stylist of world renown (Pl. R. 55a-60a). Defendant's exhibits were objected to by the plaintiff as improper. Plaintiff also denied that elements of the patented construction were old or that they op-

erated in the patented construction as did elements of the prior art.

At the oral argument on motion on May 24, 1954, defendant made a long oral presentation during which it sought to secure final adjudication of all issues on the basis of a wholly confusing and improper demonstration of a distorted sample of the accused device, in effect merely a piece of dusty and scratched plastic lying by itself on the floor. The Court, in effect, admitted its unfamiliarity with the technical matters involved and wished to ask questions "no matter how it sounds" (Pl. R. 67a-69a).

However, just as plaintiff-petitioner started its oral presentation, the Court adjourned the hearing, because of the late hour, to a new date, July 12, 1954.

In so adjourning the hearing to a new date, the Court stated that it wished to be free to make a decision if the material then before the Court "satisfied all the questions raised here today" (Pl. R. 70a). *The Court also stated that otherwise the parties would hear from the Court before July 12, so the parties would have ample time, if the Court wanted "to accept some other date"* (De. R. 89b, 97). Finally the Court instructed the defendant to present a new sample of the accused hood that would be acceptable to both parties, before the Court would act on the motion (Pl. R. 70a).

On July 9, 1954, the plaintiff received a letter from the defendant's counsel, written at the request of the Court to inform plaintiff-petitioner that due to the Court's *heavy load of work* the hearing was further adjourned until September 20, 1954 (Pl. R. 71a).

Thereupon, on August 20, 1954, i.e. one month in advance of the adjourned date, to the surprise of the

plaintiff-petitioner, the District Court made and entered an Order with opinion, adjudicating all issues of the cause, declaring the patent invalid and uninfringed.

Defendant withheld presentation of the new sample for almost three (3) months after the Court's instructions to present such exhibit and stipulate with plaintiff "as to what it is" (Pl. R. 70a). But only (3) days before entry of the Court's order, defendant notified plaintiff as to location of some such hoods (Pl. R. 73a).

As a result, the District Court never saw the device in operation. The plaintiff-petitioner not only could not present his proofs but even could not make oral argument on the motion for summary judgment, or even explain to the Court how the device actually operated.

The opinion of the District Court contains nothing to show that the Court understood what the problem of the prior art was, or that the gist of invention was in the change of the engine hood from the full transparency to expose automobile interior to full view to non-transparency to make such interior invisible and thus to complete the outer surfaces of the body and the elegance and beauty of the artistic lines thereof, or that this feature was even involved in the operation of the patented device.

In the proceedings before the Court of Appeals, the defendant shifted its position with respect to some prior allegations of material facts and raised new issues of fact immediately joined by plaintiff-petitioner.

Defendant also represented to the Court of Appeals by new photographs and other material not therefore

on the record that use of automobile displays in accordance with plaintiff-petitioner's disclosures was discontinued by the defendant after one year's campaign as unsuitable for "rough roads", and was substituted by the cutting of windows in steel engine hoods. Plaintiff-petitioner denied reasons of the defendant as a subterfuge resorted to by the defendant. At the time of making such presentation to the Court of Appeals, defendant was preparing displays of its Chevrolet automobiles in accordance with plaintiff's disclosure, including a mammoth stand moving a full size Chevrolet automobile like a toy through a cycle of motions, toward and away from the observer, to demonstrate the surprising change of the all-plastic engine hood from full transparency to expose the interior, to full non-transparency to make the interior invisible and to complete the exterior surfaces of the body lines. Such displays were exhibited several weeks later, and demonstrated for thousands to see the very gist of petitioner's invention, which never became known to the courts below.

The Court of Appeals affirmed summary holding of invalidity on the ground that invention was simple and comprehensible by the Court without expert testimony; that it had not met the high standard of invention established by this Court; that the exhaustive discovery eliminated all factual issues; that in view of invalidity of the patent all other questions and issues became moot.

REASONS FOR GRANTING THE WRIT

The writ of certiorari shold be granted for the following reasons:

1. To resolve the conflict between the decision of the United States Court of Appeals for the Sixth Circuit appealed from and the decision of the United States Court of Appeals for the Ninth Circuit in *Hycon Mfg. Co.* v. *H. Koch & Sons,* 1955, 219 Fed. 2nd 353, as to whether or not district courts have power to make final adjudication of patent causes, particularly on the issue of validity in view of the prior art, by summary judgments after consideration of the pre-trial record in chambers and in spite of the fact that patentee seeks to present proofs on the issues before the court.

2. To resolve the uncertainty caused by the interpretation of the decision of this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.,* 340 U.S. 147, as having established a high standard of invention, which "simple" inventions cannot meet, thus entitling the defendant in such a case to judgment in its favor as a matter of law and, consequently, by way of a summary judgment.

3. To review and to limit the resulting growing tendency on the part of the courts to dispose of patent cases by way of summary judgments.

4. To prevent further development of a resulting situation already evolving in the automobile industry, which is not in accord with the constitutionally intended operation of the patent system.

1.

The Decision of the Court of Appeals Is Not Justified by, and Is Contrary to the Applicable and to the Applied Decisions of This Court and Is in Direct Conflict With a Decision of the Court of Appeals for the Ninth Circuit

(a)

In the appealed decision, the Court of Appeals for the Sixth Circuit held, in effect, that the District Court was justified in adjudicating the issue of validity of the patent in suit in view of the prior art, without a trial but by study in chambers of the prior art and various documents contained in the pre-trial record, if the Court could understand the same without the help of experts; that the Court could study exhibits without a trial and make deductions therefrom as to what matters such exhibits were intended by the parties to demonstrate and how such matters bear on the issues before the Court; that the Court need not bind itself to give hearing to the parties or to the plaintiff; that denials of plaintiff's opposing affidavits or his efforts to present his proofs were immaterial to the Court's power to make a summary judgment.

On the other hand, the Circuit Court of Appeals for the Ninth Circuit held that motion for summary judgment in a patent case, particularly on the issue of validity, cannot be granted even when both sides move for it. That even when all facts are stipulated, submission on that basis would require a trial. And where there was an effort to present some testimony, which was precluded by summary judgment, the case must be remanded for trial.

In the appealed decision, the Court of Appeals for the Sixth Circuit held, in effect, that when the district court considers discovery to be exhaustive and elimi-

nating factual issues, it can assume that all proofs are documentary and are all before the Court. And if the Court can understand the subject matter of the invention without expert help, it should give summary judgment and thus save parties expense of trial.

On the other hand, the Court of Appeals for the Ninth Circuit held that even if the proof is all documentary and is all before the trial court, the existence of the basis of fact in documentary form or in agreed statement of the parties does not transmute such propositions into question of law; that any tendency to abolish trial in patent cases for consideration of documents in camera should be curbed.

(b)

In confirming the summary order of the District Court, the Court of Appeals for the Sixth Circuit relied heavily on the decisions of this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147. However, in applying these decisions and suggesting that they support a summary disposition of patent cases, the Court of Appeals interpreted these decisions beyond their actual holding and thus, in effect, authorized a departure from the established procedure of adjudicating patent causes.

Both of these cases were decided after full trials, with the respective plaintiffs given full opportunity to bring their proofs to disprove in open court the charge of obviousness.

In the decision appealed from, plaintiff's efforts to bring his proof were blocked by the defendant's

motion for summary judgment. The evidence in possession of the plaintiff was of a nature which, under many decisions of this Court, was material on the issues before the District Court.

Unlike in the applied decisions, summary decision of the District Court in the present case enabled the defendant to suppress plaintiff's vital evidence and proofs. The Court of Appeals failed to dispose of this question and did not mention it in its decision.

In *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, as the result of the open trial it was found that all of the elements of the claimed patented combination were old and there was no finding that they performed any additional or different function in the combination than they performed out of it. There was no dispute in that case, as there was in the present case, as to how the patented device operated. In the present case, the plaintiff denied that elements of the patented combination operated in the same manner as elements of the constructions of the prior art.

Plaintiff-petitioner sought to present at the trial evidence by testimony of witnesses, including his own testimony, and demonstration of physical exhibits that operation of the patented device and of the accused device was entirely different from what defendant said, and that critical advantages of plaintiff's device were not apparent from the record or from the defendant's exhibits which were misleading and concealed the true operation of the patented device; that elements of the patented construction operated differently from those of the prior art and were not the same elements; that the problem solved by the pat-

ented device was one of long standing which those skilled in the art failed to solve after numerous attempts; that the patented solution produced new and unexpected results and that the defendant itself admitted this fact in the most emphatic and undeniable manner as proved by evidence not yet before the court. Defendant denied these facts. Yet the District Court found that there was no dispute as to any material facts and denied plaintiff-petitioner a trial.

The doctrine not disputed by the plaintiff-petitioner that the District Court has the discretion to dispense with the help of experts if the court understands the testimony is *not* the authority to refuse the very presentation of the testimony and to deny trial. Rather it is a substitution of the court's own knowledge of a fact for that of a witness. A presumption that invention cannot be anything else or involve anything else than the court derived from the pre-trial record on the basis of the court's own knowledge or study of the art and after hearing the defendant only is a presumption which, in many cases, may result in great embarrassment of judicial process as was shown in an early but strikingly similar case, *Hogan et al.* v. *Westmoreland Specialty Co., et al.*, 163 Fed. 289 and 167 Fed. 327, C.C.A., 3rd Cir. The decision in that case is also in direct conflict with the decision appealed from.

No court was ever able to give a test or definition of invention, or a legal formula to determine, apart from all pertinent facts of the case, whether a patented construction was or was not obvious to those skilled in the art. In *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, this Court emphatically stated that the Court was not giving such a

definition then, and that the Court had never ventured to give it. Giving such a definition would be, in effect, providing a formula for determining whether or not in devising a patented construction the inventor reached beyond the expected performance of a prudent man skilled in that particular art. Such legal formula or definition for the purposes of patent law is no more possible than a definition or formula for the purposes of other fields of law to determine whether a person in his conduct went beyond the expected behavior of a reasonably prudent man. An answer to such question cannot be given by taking an act in a vacuum, i.e. by itself, and apart from *all* pertinent facts of the case.

In *United States* v. *Esnault-Pelterie*, 299 U.S. 201, this Court stated that "Validity and infringement are ultimate facts on which depends the question of liability. In actions at law they are to be decided by the jury."

By the decision in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, this Court has not taken away from the patentee his right, respected by the courts for over 100 years in adjudicating patent cases, to present in open court for everyone to hear evidence disproving defendant's allegations of obviousness and invalidity of the patent. By the decision appealed from, the Court of Appeals, in effect, has authorized denying the patentee such right.

There is no such authority granted to the district courts by the decisions of this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, or in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84. Decisions of other

circuit courts of appeal relied on by the courts below also do not provide such authority. They are cases where issue of validity was not adjudicated or where both parties stipulated operative facts or even moved for summary judgment jointly, or where no evidence was admissible on the issues which were before the court. The Court of Appeals decided in this case the issue of validity only.

(c)

The Court of Appeals, in effect, authorized district courts to declare patents invalid by making from a pretrial record a series of progressive presumptions, one based on the other, and without allowing the patentee to disprove any of them.

The fact that the district court, after listening to the defendant only, may feel that it understands the record fully is a mere presumption until the court hears the plaintiff's side. Until the court understands by listening to both sides how the patented device operates and sees exhibits of both sides, rather than exhibits of one side only and objected to by the other side at that, a finding that invention is simple and its operation is clear from the record would also be a mere presumption. Even if the invention is simple, the problem which it solved may be one of great technological complexity and difficulty. Therefore, finding that since the invention is simple, so must have been the problem that it solved, and, therefore, the solution was obvious to anyone skilled in the art, is making more presumptions.

If the plaintiff is denied the right to present his proofs in such a situation, the results of such procedure is, in effect, substitution of the presumption of validity

of an issued patent by a *conclusive* presumption of invalidity. In *Hycon Mfg. Co.* v. *H. Koch & Sons,* C.C.A. 9th Cir., 1955, 219 Fed. 2nd, 353, the Court stated: "Because of the peculiar character of the process of reconsideration by a court in a field where presumption of validity of an administrative finding has, to say the least, been weakened, any tendency to abolish trial in patent cases for consideration of documents in camera should be curbed."

A patent, that is conclusively presumed to be invalid as soon as defendant makes a motion for summary judgment alleging its obviousness and invalidity, is a useless and wholly meaningless grant. Such a grant would be greatly inferior even to the registration of a claim of copyright, since, on the basis of the latter, plaintiff still can bring his proofs to disprove lack of originality.

2.

Plaintiff-Petitioner's Main Evidence and Physical Exhibits Were Not on Discovery Record on Which Summary Judgment Was Made and Were Never Seen by the District Court

(a)

There were no formal defects in the patent in suit. There was no stipulation of the parties regarding operative facts of the case, but on the contrary there was a sharp dispute.

Therefore, deciding such a case on the pre-trial record in view of, in effect, an assumption that the discovery record contained all the proofs which the patentee could present was, in effect, a failure to distinguish between discovery and proof.

Plaintiff-petitioner's diagrams (Pl. Ex. D, E, F, G,—Pl. R. 61a-64a) attached to his answer to the motion did not contain his material proofs. They were presented merely to defeat defendant's maneuver to get summary judgment by avoiding presentation of a proper sample of the accused device and contending that plaintiff admitted absence in the accused hood of some elements of the claimed combination. Plaintiff's charts merely specified by what evidence these and other allegations of defendant were to be disproved at the trial.

Deposition of plaintiff-petitioner Bobertz relied on by the defendant and the courts below was taken four (4) years prior to the motion for summary judgment and did not include plaintiff-petitioner's testimony to be given at the trial and based on evidence secured over the period of four (4) years. Neither was it a proof that solution of the problem of the prior art must have occurred to plaintiff-petitioner as obvious after he saw a Plymouth automobile on the street with holes cut in the sides of the steel engine hood. Plaintiff-petitioner was to disprove such a presumption at the trial by evidence showing that such holes were cut in steel engine hoods several times over the period of twenty (20) years prior to his invention, and several such automobiles had been driven around the country without inspiring anyone else to make plaintiff's solution or making it obvious.

Deciding cases on a discovery record affords possibilities of mistaken decisions on insufficient evidence, wrong evidence, as well as the danger that such decision would not even produce a record from which it could be ascertained later what the actual facts of the case were, what evidence the patentee sought to

produce in order to disprove defendant's allegation of invalidity, and why such evidence was not admitted. The process of making such decisions may be administrative rather than judicial in its nature.

(b)

Where such a drastic remedy as denying parties a trial is involved, it is essential that the procedure established for summary judgments be strictly followed and safeguards for protection of the parties be observed, lest summary judgments change the established court procedure for adjudication of civil causes and become a vicious means for suppressing the truth.

This Court by *Sartor et al.* v. *Arkansas Natural Gas Corp.*, 1944, 321 U.S. 620, authorized summary judgment only where it is quite clear what the truth is and no genuine issues remain for trial.

Accordingly, the circuit court of appeals repeatedly cautioned the district courts that any doubt should be resolved against granting a summary judgment; that plaintiff has the right to trial where there is the slightest doubt as to the facts. Particularly, it was held that summary judgment upon a motion therefor by a defendant should never be entered except where the defendant is entitled to its allowance beyond all doubts, *Taylor* v. *Black, Sivalls & Byson, Inc.*, C.C.A., 8th Cir., 1951, 189 Fed. 2nd 213. That the summary procedure does not apply unless evidence is too incredible to be accepted by reasonable minds or is without legal probative force even if it is true, *Cases* v. *U. S.*, C.C.A., 7th Cir., 1954, 211 Fed. 2nd 249. That where evidence is such that conflicting inferences could be drawn therefrom, the District Court has no jurisdiction on motion for summary judgment to determine

what such inferences should be, *Paul E. Hawkinson Co.* v. *Dennis et al.*, C.C.A., 5th Cir., 1948, 166 Fed. 2nd 61. The court held also that considerations of saving time for litigants should be applied with caution, since time has often been lost by reversals of summary judgments improperly entered. Particularly, in *Doehler Metal Furniture Co., Inc.* v. *United States*, C.C.A. 2nd Cir., 1945, 149 Fed. 2nd 135, the Court stated: "Such a judgment, wisely used, is a praiseworthy time saving device. But, although prompt dispatch of judicial business is a virtue, it is neither the sole nor the primary purpose for which courts have been established. Denial of a trial on disputed facts is worse than delay."

The procedure followed by the District Court on defendant's motion for summary judgment in the present case was contradictory and led to misunderstandings.

The Court's instructions to the defendant to present a new exhibit, i.e. a new sample of the accused display hood, acceptance of which was to be stipulated by both parties, and defendant's undertaking to do that was, in effect, admission of presence of disputed issues and agreement by all concerned as to the next step in the procedure. Defendant-respondent did not discharge its obligation in that respect by writing a letter to the plaintiff-petitioner, regarding location of some such hoods, three (3) days prior to entry of the summary judgment.

The notice sent by the defendant-respondent to the plaintiff-petitioner, in effect, in the name of the District Judge could be understood only in one way, namely, that the hearing was adjourned due to the Court's *heavy load of work* until September 20, 1954

(Pl. R. 71a). If it meant something else, plaintiff-petitioner was entitled to be so advised clearly.

But even assuming that such clear communication meant something different than what it expressly stated, there is a serious doubt whether it is proper for a district court on defendant's motion for summary judgment to afford defendant as full an oral hearing as defendant desired, and, thereupon, terminate further hearing on motion with a statement that plaintiff may present whatever he had for the court's inspection, and that the court wished to be free to make its decision in chambers.

Such a procedure is, in effect, substitution of open trials by administrative decisions in chambers. The courts unquestionably have the discretion to hear certain types of evidence in chambers, such as trade secrets, but even in those cases the evidence is regularly presented. In the present case, the plaintiff-petitioner had to present testimony of witnesses, demonstrate a number of physical exhibits which could be easily misunderstood or be entirely meaningless to the court without a proper demonstration. Such condition unquestionably called for a trial.

3.

Allegations of Fact Contained in the Supporting Affidavits of Defendant's Employees Were Denied by the Opposing Affidavits Presented by Plaintiff-Petitioner and Should Not Have Been Accepted as Presenting Undisputed Facts

All of the three (3) affidavits presented by the defendant in support of its motion for summary judgment were from its own employees. Opposing affidavits presented by the plaintiff-petitioner denied allegations of fact made in the affidavits presented by the defendant,

and plaintiff-petitioner was to call the affiants for cross-examination at the trial. By denying the plaintiff-petitioner a trial, the District Court, in effect, accepted the disputed allegations of defendant's affidavits as facts, rejected plaintiff-petitioner's affidavits and thus tried the case on the affidavits in advance of trial.

In *Sartor et al.* v. *Arkansas Natural Gas Corp.*, 1944, 321 U.S. 620, this Court reversed the summary judgment and held that where defendant attempted to establish absence of triable issue by affidavits of eight (8) persons, most of them defendant's own employees, and, therefore, interested witnesses, this fact gave rise to the question of credibility of such witnesses, a matter best judged at the trial.

The Court of Appeals merely stated that there was no justification for plaintiff-petitioner's complaint that the District Court should not have made or entered summary judgment after the case had been set *for trial.*

This was not the question on appeal. Plaintiff-petitioner agrees that the District Court has full discretion to make a decision on motion for summary judgment irrespective of the fact whether or not the case is set for trial. The gist of the complaint was that when such a drastic remedy as granting summary judgment is involved, granting said judgment when the *hearing on motion for summary judgment* itself is interrupted, is incomplete, and is expressly adjourned after listening to defendant only, resulted in the District Court's making the decision not on the actual facts of the case but on a set of hypothetical facts set up by the defendant to suit its piracies.

4.

The decision of the Court of Appeals for the Sixth Circuit, while not being fully predictable as to its consequences on the industry which it is to affect most, namely, the automobile industry concentrated in the Sixth Circuit, unquestionably creates serious uncertainty for nearly 30,000 manufacturer-suppliers working in that industry and investing capital into originating and developing various automobile components and parts in reliance on patent grants, and selling in that very special market, often limited to a single outlet only.

Patents of such manufacturer-suppliers have been operating to a certain extent as a stabilizing factor in that industry as a result of a naturally evolved situation. Such situation has been characterized by tacit but non-committing recognition of such patents by the portion of the industry concerned therewith, with the patent owner receiving some portion of the business in exchange for royalty-free licenses to several alternative sources of supply.

The workable balance thus achieved over quite a number of years may now be disturbed. As a result, numerous resourceful concerns having considerable investment of capital in plants and research facilities may now be put into a position of total insecurity for their investment and total dependency on a chance in an extremely limited and uncertain market. Such condition cannot encourage investment and progress of the industry but may force many withdrawals therefrom with wasteful liquidation of highly specialized equipment and other assets, and dispersement of skilled personnel and labor. Such a condition may not operate

for the benefit of the automobile industry in its entirety and is not in the public interest. Such uncertainty should be resolved.

CONCLUSION

WHEREFORE, your Petitioner respectfully prays in this petition that this Honorable Court grant a writ of certiorari and bring before this Court the decision of the United States Court of Appeals for the Sixth Circuit.

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Petitioner

APPENDIX

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

No. 9399

GUSTAV H. BOBERTZ, JR., *Plaintiff*,

v.

GENERAL MOTORS CORPORATION, *Defendant*.

Order Granting Defendant's Motion for Summary Judgment

Plaintiff sues for infringement of Patent No. 1,911,600 relating to improvement in automobile hoods. Defendant denies infringement and attacks validity of the patent for lack of novelty and patentable invention. Issue was joined, pre-trial hearing had and a pre-trial order entered defining the issues, following which exhaustive discovery proceedings ensued by both parties.

Defendant filed motion for summary judgment under Rule 56, claiming absence of any genuine issue of material fact. Oral argument was had and all exhibits were made available to the court, including defendant's accused device. Briefs were filed fully covering the issues involved.

Ordinarily, courts are reluctant to decide important issues by summary judgment because of the lack of a record adequate to explain the issues of fact and law. Parke, Davis & Co. v. American Cyanamid Co. et al., (6 Cir.), 207 F. 2d 571, citing Estepp v. Norfolk & W. Ry. Co., (6 Cir.), 192 F. 2d 889. In the latter, a personal injury case, and in Begnaud et al v. White, (6 Cir.), 170 F. 2d 323, a contract case, the court ruled that where a genuine issue of material fact exists summary judgment should not be granted, but in the Parke, Davis & Co. v. American Cyanamid Co. et al. case, supra, a patent case, the court said, p. 573, "but here the issues are clarified by extensive interrogatories filed by both parties and answered fully".

Both parties in this case resorted to extensive discovery proceedings, filing of affidavits and exhibits, and making admissions. The court also had the benefit of the Patent Office file wrapper showing the history of the prosecution of this patent. The thoroughness of the pre-trial activities of both parties resulted in the elimination of any genuine issue of material fact in dispute. Under such circumstances it has been held that where no factual issues are present and where the patents and products involved are sufficiently simple to make expert testimony unnecessary, disposition under Rule 56 is proper. Bridgeport Brass Co. v. Bostwick Laboratories, (2 Cir.), 181 F. 2d 315, 316, 319; Steigleder v. Eberhard Faber Pencil Co. et al., (1 Cir.), 176 F. 2d 604, certiorari denied, 338 U.S. 893; Vulcan Corp. v. International Shoe Machine Corp., D.C.D. Mass., 68 F. Supp. 990, affirmed 1 Cir., 158 F. 2d 520, certiorari denied, 330 U.S. 825, 67 S. Ct. 868, 91 L. Ed. 1275; Alex Lee Wallau, Inc. v. J. W. Landenberger & Co., 121 F. Supp. 555, 556. Defendant's accused hood is a partially transparent counterpart of the regular steel hood used in all of defendant's 1949 Oldsmobile "Rocket Engine" automobiles. Both hoods were available to the court for examination and comparison with plaintiff's hood of the claimed invention, which in Figure 2 of the patent drawings follows closely the automobile hood structure of defendant's 1932 Chevrolet automobile.

In Steigleder v. Eberhard Faber Pencil Co. et al. case, supra, the court in approving disposition of certain patent cases under Rule 56 said: "Where it is apparent that there is no genuine issue of fact bearing on infringement, and the structure and mode of operation of the accused device are such that they may be readily comprehended by the court, and compared with the invention described and claimed in the patent, without the need of technical explanation by the testimony of expert witnesses, then the court, if satisfied that there is no infringement, should give summary judgment for the defendant, instead of

subjecting the parties to the expense of a trial." To the same effect Smith v. General Foundry Mach. Co., (4 Cir), 174 F. 2d 147, certiorari denied, 338 U.S. 869.

The five combination claims of the patent in suit are directed to an automobile hood made of transparent material, consisting of two vertical members, and either one or two horizontal members with a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom, and securing means adapted to coact with a hold-down latch on the vehicle body to removably secure the hood to the vehicle body. The specifications state the object of the patent to be an invention to provide an automobile hood formed of transparent material, which permits full visibility of an engine of a motor vehicle at all times. Claim 1 is representative.[1] This transparent automobile hood would only temporarily replace the ordinary hood and was not intended for regular use in an automobile. The novelty of this invention is stated in the specifications to reside in the transparency of the top and sides of the automobile hood, for display or study purposes, enabling the observer full visibility of the engine.

The specifications also state that the automobile hood of the invention may be formed of a single sheet of transparent material, or a plurality of independent sheets of such material, and while it is also stated in the specifications that the applicants for the patent do not desire to be limited to any type of hood fastening means, nor to a particular shape or configuration of such a hood, but desire to avail themselves of all changes in the scope of

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[1] An automobile hood including two transparent vertical members, two substantially horizontal transparent members, a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom, and securing means adapted to coact with a hold-down latch on the vehicle body to removably secure the said hood to the vehicle body.

the appended claims, it is clear upon examination of the file wrapper history of the prosecution of this patent, and the language of the claims of the patent, that the claims finally granted are expressly limited to an automobile hood of several pieces made of any transparent material and joined together by transparent reinforcing means to form a unitary structure.

The original application filed in the Patent Office had seven claims, all rejected by the Patent Office. A total of nine new claims were filed during subsequent proceedings in the Patent Office, of which five were finally allowed. These rejected claims included language relating to "transparent means for enclosing the portion of the vehicle between the radiator and the cowl"; a "transparent automobile hood formed of transparent material"; and later, "of sheet celluloid". The rejected claims presented nothing patentable over Rumpler (German) #379,379 (1923) which, in claims 1 and 4, describe a motor vehicle hood constructed from transparent celluloid. No invention is claimed on the latching means, and the substitution of the temporary hood in place of the conventional hood in an automobile is taught by Martin #1,382,959 (1921).

As pointed out by the Patent Office, the combination of a cowl, radiator shell, a hood, and the latching means for the hood, is an old one, as disclosed in Martin. No invention would be involved in substituting sheet celluloid for the wire mesh covering in Martin, in view of the transparent hood shown in Rumpler, the moulded celluloid used in Rumpler being equivalent to sheet celluloid, and the use, broadly, of transparent reinforcing means is not a patentable distinction, since an ordinary prudent mechanic would naturally locate the reinforcing means to conform with the design of the vehicle body. The reinforcing rods in Martin are adapted to conform with the design of the vehicle body, as stated by the Patent Office, and afford no basis for a patentable invention.

The patent was finally allowed only when the claims were presented in the specific language suggested by the Examiner, limiting the grant to the vertical and horizontal transparent members and reinforcing means disposed to conform the body design of the motor vehicle upon which the hood is placed, with latching means on the vehicle body.

The claims of the patent do not disclose the nature of the transparent material of which the hood is made, and although it is stated in the specifications that the hood of the invention may be formed by a single sheet of transparent material or a plurality of independent sheets of such material, the Patent Office repeatedly and finally rejected claims for a one-piece transparent hood, in view of Rumpler whose patent disclosed an automobile hood of transparent celluloid.

In 1949 defendant caused to be made and distributed to its Oldsmobile dealers a quantity of "plexiglas" transparent automobile hoods made of sheet plastic material, to be used in displaying and demonstrating its Oldsmobile "Rocket Engine" and other parts of an automobile usually located under the hood, without the necessity of raising the hood for each individual display or demonstration. This hood was made of a single sheet of material variously referred to as plexiglas, celluloid, and plastic. The transparent portion in the center of the hood covers about two-thirds of its surface.

The claims of plaintiff's patent are specific and limited to a transparent hood consisting of separate vertical and horizontal parts joined together by reinforcing means, in order to form a unitary structure. Defendant's accused hood is made in one piece, with six ordinary screw-fastenings openings for attachment to the body and chassis of the car, without separate vertical members and without any reinforcing means connecting together the several pieces of transparent material comprising the structure of the patent.

During the prosecution of his application in the Patent Office plaintiff cancelled claims sufficiently broad in scope to cover the one-piece hood which was made of a single sheet of transparent plastic and took the claims of the patent which are specific to the plural-piece hood as illustrated in Figures 1 and 2 of the patent, with the reinforcing ribs connecting the individual members. By cancelling his original claims plaintiff created an express limitation relating to the inventive step, and cannot now be permitted to depart from the plain meaning of the language he adopted or to claim from such language a broad and generic construction. A. O. Smith Corporation v. Lincoln Electric Co., (6 Cir.), 82 F. 2d 226, 229. In determining the scope of a patent, intent and inventor's own appraisal of the nature of the invention are important; that which is not literally within a claim does not infringe. Directoplate Corp. v. Donaldson Lithographing Co., (6 Cir.), 51 F. 2d 199, 202. Having finally drawn his claims narrowly to avoid the prior art and obtain allowance of the claims, plaintiff cannot now attribute a broader construction to the words of his claims. Falkenberg v. Golding et al., (7 Cir.), 195 F. 2d 482. Plaintiff's claims must be read in the light of the invention disclosed and cannot be given a construction broader than the teachings of his patent as shown by the claims allowed. Ford Motor Co. v. Gordon Form Lathe Co., (6 Cir.), 87 F. 2d 390, 392; Blanc v. Curtis, (6 Cir.), 119 F. 2d 395, 397.

In Midland Steel Products v. Clark Equipment Co., (6 Cir.), 174 F. 2d 541, 545, the court quotes from D'Arcy Spring Co. v. Marshall Ventilated Mattress Co., (6 Cir.), 259 F. 236, 240, 241, "* * * where the claim defines an element in terms of its form, material, location or function, thereby apparently creating an express limitation, where that limitation pertains to the inventive step rather than to its mere environment, and where it imports a substantial function which the patentee considered of importance to his invention, the court cannot be permitted to say that

other forms, which the inventor thus declared not equivalent to what he claimed as his invention, are nevertheless to be treated as equivalent, even though the court may conclude that his actual invention was of a scope which would have permitted the broader equivalency.", citing R. M. Hollingshead Co. v. Bassick Mfg. Co., (6 Cir.), 73 F. 2d 543, 548; Firestone Tire & Rubber Co. v. United States Rubber Co., (6 Cir.), 79 F. 2d 948, 955; United Shoe Machinery Corp. v. O'Donnell Rubber Products Co., (6 Cir.), 84 F. 2d 383, 386; Shearer v. Atlas Radio Co., (6 Cir), 94 F. 2d 304, 306; A. O. Smith Corporation v. Lincoln Electric Co., (6 Cir.), 82 F. 2d 226, 229." See also Whitman et al. v. Andrus, (6 Cir.), 194 F. 2d 270.

When claims are rejected and withdrawn while invention is pending in the Patent Office the patentee is estopped to contend that the allowed claims should be given the same breadth and interpretation as the abandoned claims. Baker-Cammack Hosiery Mills v. Davis Co., (4 Cir.), 181 F. 2d 550, 563; Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 136. In the case of Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 220 the court said: "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." And, in Smith v. Magic City Kennel Club, Inc., 282 U.S. 784 790 the Supreme Court stated the rule as follows: "The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. Sargent v. Hall Safe & Lock Co., 114 U.S. 63, 86; Shepard v. Carrigan,

supra, 598; Hubbell v. United States, supra, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. Morgan Envelope Co. v. Albany Paper Co., 152 U.S. 425, 429."

Besides the Rumpler patent, there are others in the art prior to Bobertz who taught the use of transparent hoods on automobiles, such as the French publication La Locomotion, issued February 11, 1911, and filed in the United States Patent Office January 6, 1931, showing a transparent glass hood on an automobile, and The Motor, a publication of London, England, dated July 2, 1912, showing a Cadillac automobile with a transparent glass hood. Also, in the Kelsey patent, No. 1,045,152, (1912) there is disclosure of a removable transparent dome of an airplane covering the hatchway, and a series of concave and convex transparent sections conforming to the curvature of the housing set in the bottom and sides of the housing to permit inspection of the exterior mechanisms and surface below.

A transparent automobile hood was old in the art. Whether it be made of glass, plexiglas, celluloid or plastic, its function prior to the patent here was identical with its function in this patent. The several pieces of transparent material constituting plaintiff's inventive effort function in the same manner and serve the same purpose as the prior art patents and publications without regard as to the type of transparent material described. The Bobertz patent here does not come up to the high standard of patentable invention required to sustain combination claims such as the claims in this suit. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147; Cuno Engineering Corp. v. Automatic Devices Corp. 314 U.S. 84.

The claims in suit are not limited to transparent plastic and this limitation cannot be read into the claims in

order to save them from invalidity; Patrol Valve Co. v. Robertshaw-Holton Controls Co., (C.A. 6), 210 F. 2d 146; Aluminum Company of America v. Thompson Products, Inc., (C.A. 6), 122 F. 2d 796; Parke, Davis & Co. v. American Cyanamid Co. et al., supra, in which the court stated (p. 574):

> "The appellant therefore is estopped to deny the limiting effect of the language in the claims because these limitations are adopted to avoid the earlier grounds of rejection and refusal and to obtain allowance of the patent." Citing Shepard v. Carrigan, 116 U.S. 593, 598; I. T. S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429, 433-434; Smith v. Magic City Kennel Club, Inc., 282 U.S. 784, 790, and " * * * An applicant cannot qualify the effect of his acquiescence in the rejection of a claim by stating to the Patent Office that it is not an acquiescence and that he expects to insist upon his right to cover the same ground which the rejected claim covered under other and amended claims. As declared by this court through Chief Justice Taft, then Presiding Judge, in Thomas v. Rocker Spring Co., 6 Cir., 77 F. 420, 431-432, an applicant 'cannot thus destroy the effect of a patent-office ruling.'"

As in the Smith v. Magic City Kennel Club, Inc. case, supra, plaintiff here, resorts to the doctrine of equivalents, claiming that defendant's accused structure contains horizontal and vertical members. Though this be a far fetched argument, by comparing plaintiff's structure with the accused hood, there is in any event an absence of "a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom". In the Smith v. Magic City Kennel Club, Inc. case, supra, the court further points out, p. 790, "The petitioner resorts to the doctrine of equivalents, insisting that the rigid horizontal arm of the respondents is to be treated as the equivalent of the arm of the patent, and that the limiting specifications of the claims may be ignored. What has already been said disposes of

this contention, for where a patentee has narrowed his claim, in order to escape rejection, he may not 'by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to disclaimer.' Weber Electric Co. v. Freeman Electric Co., 256 U.S. 668, 677, 678; I. T. S. Rubber Co. v. Essex Rubber Co., supra. It should also be observed that the difference here was both in structure and in mode of operation and result."

Bobertz obtained no new and unexpected results which would rise to the dignity of patentable invention, since the substitution of one material with known characteristics for another material is not invention.

In Electro Mfg. Co. v. Yellin, the court said, 132 F. 2d 979, 981,

> "Plastic products have been made for many years. They are lighter in weight than metal, are translucent, and permit greater variation in color. Nemeroff did not disclose a new material, he merely substituted a plastic material for a material which was used in the prior art, and the District Court held that this did not amount to invention. See Hotchkiss v. Greenwood, 11 How. 248, 52 U.S. 248; Evr-Klean Seat Pad Co. v. Firestone Tire & Rubber Co., 8 Cir., 118 F. 2d 600. * * * we do say that there was no patentable genius involved in Nemeroff's disclosures. This was the District Court's conclusion, and we think it was correct."

See also James Heddon's Sons v. American Fork & Hoe Co., (C.A. 6), 148 F. 2d 230, 232; Seiberling Rubber Co. v. I. T. S. Co., (C.A. 6), 134 F. 2d 71; Goodwin v. Borg-Warner Corp., (C.A. 6), 157 F. 2d 267; Timken-Detroit Axle Co. v. Cleveland Steel Products Corp., (C.A. 6), 148 F. 2d 267, 271.

The claims in suit are limited to reinforcing means shown as strips 9. The mere strengthening or reinforcement of Rumpler's plastic hood would not amount to pat-

entable invention. Associated Plastic Companies, Inc. v. Gits Molding Corp., (C.A. 7), 182 F. 2d 1000, 1005.

Defendant's accused automobile hood does not infringe plaintiff's patent. The patent itself is invalid for want of patentable invention and lack of novelty. Defendant's motion for summary judgment is granted.

ARTHUR A. KOSCINSKI
Arthur A. Koscinski,
District Judge

Dated: August 20, 1954

U. S. District Court
Eastern District of Mich. ss

I hereby certify that the foregoing is a true copy of the original on file in this court and cause.

FRANK J. DINGELL,
Clerk

By (Sgd.) JOSEPHINE M. BOWMAN
Deputy Clerk

Dated: Aug. 20, 1954

No. 12379

UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

GUSTAV H. BOBERTZ, JR., *Appellant*, v. GENERAL MOTORS CORPORATION, *Appellee*.	APPEAL from the United States District Court for the Eastern District of Michigan.

Decided December 14, 1955.

Before MARTIN, MILLER and STEWART, Circuit Judges.

MARTIN, Circuit Judge. The contest here is between Gustav H. Bobertz, Jr., owner of United States Letters Patent No. 1,911,600, covering a transparent automobile hood, and the General Motors Corporation as an alleged infringer of the patent. Plastic Unlimited, Inc., a sales corporation and not a manufacturer, was originally a party to the suit. The suit against that corporation was dismissed on motion, for the reason that the instant litigation was not begun prior to the dissolution of the corporation under the Michigan General Corporation Act, section 450.75. The complaint of Bobertz was served only about two weeks before the expiration of the patent on May 30, 1950. The patent had been issued on May 30, 1933.

Upon denial by General Motors Corporation that the patent was either valid or infringed, issue was joined and a pre-trial hearing had. Extensive discovery proceedings ensued. Pursuant to Civil Procedure Rule 56, General Motors filed a motion for summary judgment insisting that no genuine issue of material fact was pre-

sented; that the patent claims were invalid; and, moreover, that they were not infringed. The prior art was cited and documents filed establishing anticipation of the claimed invention. Several depositions and affidavits were also filed, elaborate briefs were submitted to the court, and oral arguments were presented by both sides. After due deliberation, the district court, in an opinion-order embracing a complete discussion of both the mechanical facts and the applicable law, granted defendants' motion for summary judgment on both grounds and dismissed the suit.

In his deposition, Bobertz asserted that the concept of making a transparent automobile hood came to him though observing a parked Plymouth car which attracted a number of observers because of the fact that its hood was provided with transparent windows for the purpose of making visible the engine underneath the hood. He noticed, however, that people who tried to see the engine through the small openings in the hood gave up in disgust because they could not actually see the engine. His thought was that it would be much simpler if the whole hood were made of transparent celluloid. His first practical application of this thought was to make a transparent hood for a Chevrolet automobile which duplicated in celluloid the 1932 Chevrolet hood, made of sheet steel, consisting of two substantially horizontal members hinged together at their edges along the longitudinal center of the hood. Two vertical side members were hinged to the abutting edges of the horizontal members; and the hood was secured to the chassis by conventional hood fasteners in use by Chevrolet at that time.

The patent in suit displayed a transparent hood in configuration substantially a duplicate of the sheet-metal hood placed on the Chevrolet automobile manufactured by the General Motors Corporation in 1932. Except that the hood is transparent, the claims of the patent in suit substantially describe a 1932 Chevrolet hood. As stated

by the United States District Court, the five combination claims of the patent in suit are directed to an automobile hood made of transparent material, consisting of two vertical members, and either one or two horizontal members with a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of such members to form a unitary structure therefrom, and securing means adapted to coact with a hold-down latch on the vehicle body to secure removably the hood to the body of the vehicle. The specifications state that the object of the patent is to provide an automobile hood of transparent material permitting at all times full visibility of the engine of a motor vehicle. The specifications declare the novelty of the invention to reside in the transparency of the top and sides of the automobile hood, affording full visibility of the engine. The transparent automobile hood was not intended to be used regularly, but only temporarily to replace the ordinary hood.

The District Court quoted Claim One of the patent as representative. Claim Four is also typical, and reads as follows: "An automobile hood including two transparent vertical members, two substantially horizontal transparent members, a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom, and means secured to said hood and adapted to permit removable attachment of said hood to a motor vehicle body."

The District Court asserted that it is clear from consideration of the file-wrapper history of the prosecution of the patent in suit and from the language of the patent claims that the claims finally granted were expressly limited to an automobile hood of several pieces made of any transparent material and joined together by a transparent reinforcing means to form a unitary structure.

All seven claims of the original application filed in the Patent Office were rejected; and a total of nine new claims were filed during subsequent proceedings in the Patent Office whereof five were finally allowed. The rejected claims embraced such language as "transparent means for enclosing the portion of the vehicle between the radiator and the cowl"; "transparent automobile hood formed of transparent material"; and the words "of sheet celluloid."

The District Court found that the rejected claims presented nothing patentable over Rumpler (German) Patent No. 379,379 (1923) which, in Claims One and Four, describe a motor vehicle hood constructed from transparent celluloid. The comment was made that no invention is claimed for the latching means, and that the substitution of a temporary hood in place of the conventional hood was taught in 1921 by Martin in Letters Patent No. 1,383,959.

As pointed out by the Patent Office, the combination of the cowl, radiator shell, hood and latching means therefor is old as disclosed in Martin, no invention being involved in substituting sheet celluloid for the wire-mesh covering employed in Martin, in the light of the transparent hood shown in Rumpler. The court stated that the moulded celluloid used in Rumpler is equivalent to sheet celluloid and the broad use of transparent reinforcing means is not a patentable distinction for the reason that an ordinarily prudent mechanic would naturally locate the reinforcing means to conform to the design of the body of the vehicle. The reinforcing rods in the Martin patent are adapted to conform to the design of the vehicle body, as stated by the Patent Office, and afford no basis for patentable invention.

The final allowance of the patent claims ensued only when the claims were presented in specific language suggested by the examiner. The claims for a one-piece

transparent hood were rejected by the Patent Office on the prior art of Rumpler, who disclosed in his patent an automobile hood of transparent celluloid. The claims of the patent in suit do not disclose the nature of the material of which the hood is to be made. The claims of the patent seem specific and limited to a transparent hood consisting of separate vertical and horizontal parts, joined together by reinforcing means, in order to form a unitary structure.

The inventors, while pursuing the application in the Patent Office, cancelled claims sufficiently broad in scope to cover a one-piece hood made of a single sheet of transparent plastic and adopted claims specific as to a multiple-piece hood with reinforcing ribs connecting the individual members.

In *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 220, 221, the Supreme Court said: "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. [Citing cases.] The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. [Citing cases.] The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revise cancelled or rejected claims and restore them to their patents are manifest. See *Leggett* v. *Avery*, 101 U. S. 256, 259. True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower. [Citing cases.]" Cf. *Smith, Administratrix,* v. *Magic City Kennel Club, Incorporated*, 282 U. S. 784, 790.

The opinion of this court in *A. O. Smith Corporation* v. *Lincoln Electric Co.*, 82 F. (2d) 226, 229, 230 (C. A. 6), declared that the inventor had created an express limitation pertaining to the inventive step, and would not be permitted to depart from the plain meaning of the language he adopted, or to claim for such language a broad and general construction. It was asserted that the file wrapper confirmed the conclusion that the inventor had deliberately limited his claim in a specified manner and that the claim, read in the light of the specifications, measures the invention. See also *Falkenberg* v. *Golding*, 195 F. (2d) 482, 485 (C. A. 7); *Midland Steel Products Co.* v. *Clark Equipment Co.*, 174 F. (2d) 541, 545 (C. A. 6); *D'Arcy Spring Co.* v. *Marshall Ventilated Mattress Co.*, 259 Fed. 236, 240, 241 (C. A. 6); *R. M. Hollingshead Co.* v. *Bassick Mfg. Co.*, 73 F. (2d) 543, 548 (C. A. 6); *Firestone Tire & Rubber Co.* v. *United States Rubber Co.*, 79 F. (2d) 948, 955 (C. A. 6); *Directoplate Corporation* v. *Donaldson Lithographing Company*, 51 F. (2d) 199 (C. A. 6); *Baker-Cammack Hosiery Mills* v. *Davis Co.*, 181 F. (2d) 550, 563 (C. A. 4).

The claims of a patent are to be interpreted, not only in the light of the specifications, but also with reference to file-wrapper history. *Whitman* v. *Andrus*, 194 F. (2d) 270, 275 (C. A. 6); *Schriber-Schroth* v. *Cleveland Trust Co.*, *supra*.

In addition to the German patent issued to Rumpler, No. 379,379, there is in the record documentary evidence, which was presented to the trial judge, that the prior art before the Bobertz patent disclosed an automobile hood of such transparent material that the engine could be viewed. In the issue of February 11, 1911, of a French publication, La Locomotion, there was depicted a glass hood for demonstrating the engine of an automobile of that period. The fact that the hood revealed in La Locomotion, was made of glass and not of plastic is im-

material, for the claims of the patent in suit are not limited to plastic, the use of which in automobile hoods had been revealed in Rumpler. In United States Letters Patent No. 1,045,152, issued to Kelsey on November 26, 1912, covering a "flying machine," transparent sections of celluloid or other transparent material were directed to be so placed that the operator could view "both the operation and adjustment of the mechanism below the plane." A journal published in London, England, The Motor, in its issue of July 2, 1912, showed a Cadillac automobile with a transparent glass hood. In another publication, The Autocar, of date September 28, 1914, this sentence appears: "A very striking feature about the car is a glass bonnet that Mr. Bennett has introduced for trial and demonstration work, and one which apparently attracts a great deal of interest to the car. [A Cadillac.]"

The District Court logically reasoned: "A transparent automobile hood was old in the art. Whether it be made of glass, plexiglas, celluloid or plastic, its function prior to the patent here was identical with its function in this patent. The several pieces of transparent material constituting plaintiff's inventive effort function in the same manner and serve the same purpose as the prior art patents and publications, without regard as to the type of transparent material described. The Bobertz patent here does not come up to the high standard of patentable invention required to sustain combination claims such as the claims in this suit. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147; *Cuno Engineering Corporation* v. *Automatic Devices Corp.*, 314 U. S. 84. The claims in suit are not limited to transparent plastic and this limitation cannot be read into the claims in order to save them from invalidity." *Patrol Valve Co.* v. *Robertshaw-Fulton Controls Co.*, 210 F. (2d) 146 (C. A. 6); *Aluminum Company of America* v. *Thompson Products, Inc.*, 122 F. (2d) 796 (C. A. 6); and *Parke-*

Davis & Co. v. *American Cyanamid Co.*, 207 F. (2d) 571 (C. A. 6), were appropriately cited as authority.

Mere substitution of materials, when no new results are accomplished, does not attain the dignity of invention. *Timken-Detroit Axle Co.* v. *Cleveland Steel Products Corporation*, 148 F. (2d) 267, 271 (C. A. 6); *James Heddon's Sons* v. *American Fork and Hoe Co.*, 148 F. (2d) 230 (C. A. 6); *Seiberling Rubber Co.* v. *I. T. S. Co.*, 134 F. (2d) 871 (C. A. 6); *Goodwin* v. *Borg-Warner Corporation*, 157 F. (2d) 267, 274 (C. A. 6); *United States Appliance Corporation* v. *Beauty Shop Supply Co.*, 121 F. (2d) 149, 150 (C. A. 9); *Hinchman* v. *Jim Robbins Co.*, 113 F. Supp. 302, 304 (E. D. Mich.; Levin, J.).

The Court of Appeals for the Seventh Circuit, in *Electro Mfg. Co.* v. *Yellin*, 132 F. (2d) 979, 981 (C. A. 7), said: "Plastic products have been made for many years. They are lighter in weight than metal, are translucent, and permit great variation in color. Nemeroff [inventor of the patent there in suit] did not disclose a new material, he merely substituted a plastic material for the metal which was used in the prior art, and the District Court held that this did not amount to invention. [Citing cases.] Moreover, the use of transparent and translucent ends for lighting fixtures is old. We do not say that the design patents referred to anticipate the patent in suit, yet we do say that there was no patentable genius involved in Nemeroff's disclosures. This was the District Court's conclusion, and we think it was correct."

It seems almost idle to reiterate that quite a high standard of invention is now exacted to sustain combination claims embracing old elements in a patent. This was made plain fourteen years ago in the opinion of the Supreme Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90-92. Any lingering doubt as to the intention of the Supreme Court to require strict rather than liberal construction of combination claims was certainly dispelled by its opinion in *Great Atlantic*

& Pacific Tea Company v. *Supermarket Equipment Corp.*, 340 U. S. 147, 154, where the majority opinion concluded that the standard of invention used in the lower courts was less exacting than that required where a combination was made up entirely of old components.

In *General Motors Corp.* v. *Estate Stove Co.*, 203 F. (2d) 912, 917, 918 (C. A. 6), Judge McAllister thus expressed the view of this court: "In an able and ingenious argument, appellee submits that, in specifying a new statutory standard of invention, the Act does not treat combination patents on a different basis from other patents, as it is claimed the Supreme Court did treat them in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162; that the new Section 103 defines a single standard of invention for all patents; that the subject matter as a whole would not have been obvious at the time the invention was made; and that the extent to which the *Great Atlantic & Pacific Tea Co.* case required a different, or more exacting standard, or a more severe test for combination claims than the single standard of invention for all patents, was rejected by Congress in the new Act. We are, however of the view that the priniciple stated in the *Great Atlantic & Pacific Tea Co.* case is not modified by the new Act, but continues to be the law, and is here controlling."

The Court of Appeals for the Seventh Circuit, in *Associated Plastics Companies* v. *Gits Molding Corporation*, 182 F. (2d) 1000, 1005 (C. A. 7), has well said: "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display invention, more ingenuity than the work of a mechanic skilled in the art. Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee. The primary purpose of our patent system is not reward of the individual but the advancement of the arts and

sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure."

The claimed invention of Bobertz merely duplicated in transparent plastic the conventional Chevrolet hood which was in use in 1932. Bobertz's idea stemmed from his observation of a Plymouth hood having transparent windows for the observation of the engine underneath the hood. The transparent hood designed by Bobertz emanated from an obvious step which might reasonably have occurred to a mechanic skilled in the art.

The appellant patent owner insists that the District Court erred in sustaining the motion of appellee for summary judgment on the ground that the patent is invalid for lack of invention in view of the prior art. The insistence is that there were material issues of fact to be tried, that the court disregarded the presumption of validity from the issuance of the patent by the United States Patent Office and upon subsidiary grounds: all challenging the right of a United States District Court by summary judgment to hold the claims of the patent invalid for want of patentable invention and lack of novelty. The District Judge thus met this argument: "Defendant filed motion for summary judgment under Rule 56, claiming absence of any genuine issue of material fact. Oral argument was had and all exhibits were made available to the court, including defendant's accused device. Briefs were filed fully covering the issues involved. Ordinarily courts are reluctant to decide important issues by summary judgment because of the lack of a record adequate to explain the issues of fact and law. [Citing cases.] . . . Both parties in this case resorted to extensive discovery proceedings, filing of affidavits and exhibits, and making admissions. The court also had the benefit of the Patent Office file wrapper showing the history of the prosecution of this patent.

The thoroughness of the pre-trial activities of both parties resulted in the elimination of any genuine issue of material fact in dispute. Under such circumstances it has been held that where no factual issues are present and where the patents and products involved are sufficiently simple to make expert testimony unnecessary, disposition under Rule 56 is proper." The court cited authorities, including a patent case, *Steigleder* v. *Eberhard Faber Pencil Co.*, 176 F. (2d) 604 (C. A. 1), certiorari denied, 338 U. S. 893. The opinion in the *Steigleder* case emphasized the advantage of granting summary judgment instead of subjecting the parties to the expense of a trial, where there was no need of expert witnesses to furnish technical explanations bearing on the structure and mode of operation of fountain pens.

In *Vulcan Corporation* v. *International Shoe Machinery Corporation*, 68 F. Supp. 990 (D. C. Mass.), affirmed on opinion of the District Court in 158 F. (2d) 520 (C. A. 1), certiorari denied, 330 U. S. 825, and in *Alex Lee Wallau, Inc.* v. *J. W. Landenburger & Co., Inc.*, 121 F. Supp. 555, 556 (S. D. N. Y.), summary judgments dismissing complaints in patent cases were granted. In the last cited case, the District Judge said: "The Court of Appeals of this Circuit has indicated that the remedy of summary judgment is available in patent suits where no factual issues are raised and where the patents and products involved are sufficiently simple to make expert testimony unnecessary. *Bridgeport Brass Co.* v. *Bostwick Laboratories*, 2 Cir., 181 F. (2d) 315, 316, 319."

United States Circuit Judge Soper said: "The plaintiff makes the additional point that there is no precedent in this court for disposing of a question of patent infringement by summary judgment. The practice, however, is not unknown and is properly adopted where as provided in Federal Rules of Civil Procedure, Rule 56(c), 28 U. S. C. A., there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a

matter of law. [Citing cases.] We find that situation to prevail in the pending case." *Smith* v. *General Foundry Mach. Co.*, 174 F. (2d) 147, 151 (C. A. 4).

Where there was no genuine issue of material fact presented, this court has affirmed a summary judgment for the defendant in a patent case. *Lincoln Electric Co.* v. *Linde Air Products Co.*, 171 F. (2d) 223 (C. A. 6). So, likewise, has the Court of Appeals for the Seventh Circuit. *Davison Chemical Corp.* v. *Joliet Chemical, Inc.*, 179 F. (2d) 793, 795 (C. A. 7). Cf. *Leishman* v. *Radio Condenser Co.*, 167 F. (2d) 890 (C. A. 9).

Long before the adoption of the Civil Procedure Rules, including Rule 56, this court, in an opinion by Judge Mack (a model of brevity in a patent case) held that where the only difference between expert witnesses was not as to any technical meaning or circumstance, but as to the proper interpretation of the patent in the light of the undisputed prior art, the question was for the court and not for the jury. *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 79 (C. A. 6), decided in 1924.

The attorney for appellant is altogether too strong in his criticism of the trial judge. There is no justification in the context for his statement that "our courts are established to do justice and not merely dispose of cases in a hurried manner." Nor is there justification for his complaint that the court should not have sustained defendant's motion for summary judgment after the case had been set for trial. At the conclusion of the last hearing, the judge had stated that he wanted everything made available for his inspection and persual, so that he would not have to call up the attorneys from time to time; and that, after going through all the material before him, he would feel free to advise the attorneys of his decision, if he became satisfied as to appropriate action on all the questions raised by the motions. The judge did not bind himself to afford the parties a further hearing. He left the matter optional in his own discretion.

In addition to the prior art citations, the District Judge had before him the deposition of the plaintiff-patentee, Bobertz, and his admissions on file made under Rule 56; the depositions of Shurly, sales manager of Plastics Unlimited, and of Wood, its secretary; deposition of Skinner, vice-president of General Motors and general manager of its Oldsmobile Division, and of Chayne, vice-president of General Motors in charge of engineering; affidavits of Barton (identifying a photograph of the 1932 Chevrolet hood), and of Hirshman (identifying photographs of the 1949 Oldsmobile steel hood and the accused plastic hood); and the affidavit of Thorpe identifying the 1949 Oldsmobile steel hood. Moreover, the judge had the benefit of extensive briefs filed by attorneys for the parties. He was in full possession of all essential facts necessary for correct decision of the case.

Judge, Koscinski's logically reasoned and authoratatively supported opinion evinces no haste; but, to the contrary, manifests careful study and calm deliberation. This just jurist, working gamely as he did under the handicap of painful ill health, deserves commendation of the excellent performance of his juristic duty. We concur in the conclusion which he reached concerning the invalidity of the claims of the patent in suit. This being true, it is unnecessary for us to decide or even to discuss the question of infringement. That issue is moot. In *James Heddon's Sons* v. *American Fork & Hoe Co.*, 148 F. (2d) 230, 234 (C. A. 6), Judge Simons thus spoke for this court: "In view of our conclusion that Barnhart's claims are invalid for lack of invention, it becomes unnecessary to consider questions of priority or infringement and the judgment below is affirmed."

In the instant case, the judgment of the United States District Court is likewise affirmed, for the reason that United States Patent No. 1, 911,600, issued May 20, 1933, to Bobertz, et. al., covering a transparent hood for an automobile, is held invalid for lack of invention.

JUL 10 1956
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. [redacted]85

GUSTAV H. BOBERTZ, JR.,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 938

GUSTAV H. BOBERTZ, JR.,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

CHARACTER OF CASE AND OPINIONS OF COURTS BELOW

This is an ordinary patent suit brought by Gustav H. Bobertz, Jr. against General Motors Corporation for infringement of United States Letters Patent No. 1,911,600, issued May 30, 1933, upon application filed November 22, 1932, covering a transparent hood consisting of separate

vertical and horizontal members joined together at their adjoining edges by reinforcing means to form a unitary structure.

The patent expired May 30, 1950, about two weeks after the complaint was served on defendant (May 15, 1950). Since no other suit has been brought for infringement of this patent, this case presents no conflict of decisions between Courts of Appeals. The decision below is based on its own facts and affects no one but the litigants.

Respondent, acting under the provisions of Rule 56 of the Federal Rules of Civil Procedure, moved the District Court for Summary Judgment on the grounds of non-infringement and invalidity of the patent in suit (D. App. 21b).*

The District Court granted respondent's motion on both grounds and dismissed the complaint. The District Court's opinion is reported in 126 Fed. Supp. 780 and is printed in the appendix to the Petition herein beginning at page 1a. The Court of Appeals, Sixth Circuit, affirmed the District Court on the ground that the patent in suit is invalid for lack of invention and did not rule on the issue of infringement. The opinion of the Court of Appeals affirming the District Court is reported at 228 Fed. (2d) 94 and is printed in the appendix to the Petition herein beginning at page 12a.

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*The abbreviation "D. App." is used herein to designate defendant's (respondent herein) appendix.

STATEMENT OF MATERIAL FACTS

The Bobertz patent in suit (D. App. 6b) shows a transparent hood which in form or configuration is substantially a duplicate of the sheet metal hood used on the Chevrolet automobile manufactured and sold by General Motors Corporation in 1932. This was admitted by the patentee Bobertz (D. App. 70b, 75b) and the Court of Appeals so found (228 Fed. (2d) 94 at 99). This is also evident from a comparison of the drawings of the Bobertz patent in suit (copy appended at page 1b) with the 1932 Chevrolet hood (photograph appended at page 2b; also D. App. 52b, 53b). The claims of the patent in suit are limited to a hood made from a plurality of transparent pieces or members connected at their adjoining edges by reinforcing strips in order to form a unitary structure. Both the District Court and the Court of Appeals so found (126 Fed. Supp. 780, 782; 228 Fed. (2d) 94, 97).

In 1949 respondent introduced to the public the Oldsmobile "Rocket" V-8 engine and displayed the "Rocket" engine by means of a plastic hood (photographs of respondent's accused plastic hood appear in defendant's appendix pages 63b-66b and also plaintiff's appendix page 63a). Respondent's hood in form or shape was a duplicate of the metal production hood used on the 1949 Oldsmobiles but was made from a *single sheet* of transparent plastic material the border areas of which were blocked out by opaque paint to provide a central window through which the "Rocket" engine could be observed (D. App. 20b). Photographs of the 1949 Olds steel production hood appear in Defendant's Appendix 56b-62b.

Respondent based its motion for summary judgment on the following incontrovertible, self-proving documents; namely,

(1) A copy of the file wrapper of the patent in suit 1,911,600, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 3; D. App. 10b-19b; P. App. 114a-124a).

(2) German patent to Rumpler 379,379, issued August 20, 1923 (D. Ex. 4; D. App. 25b) and a translation of the German patent to Rumpler 379,379, August 20, 1923, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 4-A; D. App. 28b). Rumpler describes and claims an automobile having a hood of transparent celluloid.

(3) LaLocomotion—February 11, 1911, No. 23, page 65 (D. Ex. 5; D. App. 33b, 34b) and a translation of the captions under the photographs in LaLocomotion, February 11, 1911, No. 23, page 65, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 5-A; D. App. 35b). This publication shows and describes an automobile chassis in which the engine is covered by a glass hood.

(4) The Autocar—September 28, 1912, pages 570 and 571, photostatic copy authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 6; D. App. 39b). This publication shows and describes a Cadillac car with a transparent glass hood.

(5) The Motor—July 2, 1912, pages 965, 966 and 967 (D. Ex. 7; D. App. 42b). This publication shows a Cadillac car with a transparent glass hood.

(6) United States Patent No. 1,045,152, November 26, 1912, "Flying Machine," Earl H. Kelsey (D. Ex. 8; D. App. 46b). This patent shows plastic window for viewing an airplane engine.

(7) The Autocar—May 3, 1913, pages 804 and 805, photostatic copy authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 5-B; D. App. 36b).

The other proofs consisted of the deposition of petitioner-patentee, Bobertz; admissions on file made by petitioner Bobertz under Rule 36, F. R. C. P.; the uncontroverted affidavit of Barton identifying a photograph of the 1932 Chevrolet hood (D. App. 52b); the uncontroverted affidavit of Hirshman identifying photographs of the 1949 Oldsmobile production steel hood (D. Ex. 2-A) and of the accused plastic hood (D. Ex. 2; D. App. 54b); and the uncontroverted affidavit of Thorpe identifying the 1949 Oldsmobile production steel hood (D. Ex. 2-A; D. App. 67b).

COMPLAINT PROPERLY DISMISSED UNDER RULE 56 F. R. C. P.

Rule 56 of the Federal Rules of Civil Procedure provides that as to any asserted claim summary judgment shall be rendered for the moving party if the pleadings, depositions, and admissions on file show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. The procedure outlined in Rule 56 for terminating groundless litigation has been found particularly appropriate in many patent cases: *Morton Salt Company v. G. S. Suppiger Company*, 314 U. S. 488, 62 S. Ct. 402, 86 Law Ed. 363; *Automatic Radio Manufacturing Company v. Hazeltine Research, Inc.*, 339 U. S. 827, 70 S. Ct. 894, 94 Law Ed. 1312; *Steigleder v. Eberhard Faber Pencil Co.*, 176 Fed. (2d) 604 (C. A. 1); *Milcor Steel Co. v. George A. Fuller Co.*, 122 Fed. (2d) 292 (C. A. 2); *Bridgeport Brass Co. v. Bostwick Laboratories, Inc.*, 181 Fed. (2d) 315 (C. A. 2); *Mas v. Owens-Illinois Glass Company*, 222 Fed. (2d) 889 (C. A. 3), certiorari

denied 350 U. S. 1016; *Smith v. General Foundry Machine Company, Inc.*, 174 Fed. (2d) 147 (C. A. 4); *Lincoln Electric Co. v. Linde Air Products Co.*, 171 Fed. (2d) 223 (C. A. 6); *Davison Chemical Corp. v. Joliet Chemicals, Inc.*, 179 Fed. (2d) 793 (C. A. 7); *Young v. Ralston-Purina Co.*, 88 Fed. (2d) 97 (C. A. 8); *Park-in-Theatres, Inc. v. Perkins*, 190 Fed. (2d) 137 (C. A. 9).

All of the evidence relied upon by the respondent in support of its motion is in the form of self-proving documents which have not been, and could not be, contradicted in any manner by the petitioner. The structures of the plural piece transparent hood claimed in the patent in suit, of respondent's single piece plastic transparent hood, and of the transparent hoods shown and described in the prior art are simple and such that they may be readily comprehended by the Court and without the need of any technical explanation by an expert witness, and both the District Court and the Court of Appeals so held (126 Fed. Supp. 780, 781; 228 Fed. (2d) 94, 100).

The prior art German patent to Rumpler 379,379 (D. App. 25b-27b) and an English translation thereof (D. App. 28b-32b) describes an automobile hood of transparent material so that the engine can be viewed. Rumpler's claim 4 is directed to an

> "Automobile * * * characterized by a motor hood of transparent celluloid" (D. App. 32b).

The French publication "LaLocomotion" (D. App. 33b-35b) shows a glass hood for demonstrating the engine of a Bayard-Clement automobile. A photograph of "LaLocomotion" is appended at page 3b. The fact that "LaLocomotion" hood is of glass is of no materiality because the claims in suit are not limited to a plastic hood. Further, Rumpler taught the use of a plastic hood. There is addi-

tional prior art of record cited by the District Court and the Court of Appeals showing that long before the Bobertz patent in suit it was commonplace to make an automobile hood of transparent material so that the engine could be viewed, 228 Fed. (2d) 94, 97; 126 Fed. Supp. 780, 784.

The claims of a patent should be interpreted not only in the light of the specification but also in the light of its file history, *Schriber-Schroth Company v. Cleveland Trust Company*, 311 U. S. 211, 217-218, 61 S. Ct. 235, 85 Law Ed. 132, 135-136. The file history clearly shows that the patent in suit is limited to a *multiple piece* transparent hood and does not cover respondent's one piece hood. Referring to the file history, the Court of Appeals stated, 228 Fed. (2d) 94 at 97:

> "The inventors, while pursuing the application in the Patent Office, cancelled claims sufficiently broad in scope to cover a one-piece hood made of a *single sheet* of transparent plastic and adopted claims specific as to a *multiple-piece* hood with reinforcing ribs connecting the individual members." (Italics ours.)

The District Court likewise so found, 126 Fed. Supp. 780 at 783.

The principal issue in this law suit is indeed simple; namely, *did it amount to patentable invention in 1932 to duplicate in transparent material the then current Chevrolet production automobile hood?* Both Courts below answered this question in the negative.

Although respondent's accused hood (D. Ex. 2) was placed in evidence, this hood was not at all necessary to the decision of the Court of Appeals affirming the District Court on the ground that the Bobertz patent in suit was invalid. This only required an understanding of the hood shown in the patent in suit (admittedly a reproduction of

the 1932 Chevrolet hood in plastic instead of steel D. App. 70b, 75b) and of the transparent hoods shown in the prior art, such as the German patent to Rumpler 379,379 and the French publication "LaLocomotion" February 11, 1911 in the light of the high standard of invention set by this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 95 Law Ed. 162. A comparison of the patent in suit with the prior art on the issue of validity will demonstrate the simplicity of the hood structure in issue and that this Court can understand this structure without the need for any technical explanation by an expert witness.

It is clear that there is no genuine issue as to any material fact bearing on the question of validity; that the question of validity was properly determined as a matter of law, *United States v. Esnault-Pelterie*, 303 U. S. 26, 30, 58 S. Ct. 412, 414, 82 Law Ed. 625; and that the case was properly disposed of by way of summary judgment of dismissal, *Morton Salt Company v. G. S. Suppiger Company*, and other cases cited, *supra*, pages 5-6.

PETITIONER HAD AMPLE TIME, AND IN FACT FULLY PRESENTED HIS CASE AGAINST RESPONDENT'S MOTION FOR SUMMARY JUDGMENT

Respondent's motion for summary judgment was served on petitioner April 1, 1954 and the hearing on this motion before the District Court was had on May 24, 1954. Petitioner had ample time to prepare his opposition to this motion. On April 10, 1954 petitioner filed an eighteen (18) page brief opposing respondent's motion, on May 5, 1954 petitioner filed a fourteen (14) page brief analyzing the prior art, and on May 6, 1954 presented Exhibits D, E, F and G which are present in plaintiff's appendix (P. App. 61a, 62a, 63a, 64a).

Petitioner also argued in opposition to respondent's motion before the District Court on May 24, 1954 (D. App. 88b). At this hearing petitioner's counsel again referred to his detailed briefs filed in opposition to the motion (D. App. 88b). Petitioner's brief included the subject of file wrapper estoppel (D. App. 88b). At the close of the argument the District Court set a date of July 12, 1954 for resuming the hearing *if necessary* but very clearly pointed out that a further hearing might not be necessary and that he might decide respondent's motion in the interim. The District Court said:

> "* * * I probably will want to ask counsel some questions and perhaps ask for some discussion. *But if I feel, after going through all of the material that is before me that I can satisfy all of the questions raised here today on all three motions, why, I will feel free to let you know what my decision is*" (D. App. 89b). (Italics ours.)

Later on in the proceedings the District Court again said:

> "The Court: Well, I'll say this: I hope to be able to resume the hearing, *if a hearing will be necessary, or decide the motions by that time;* * * *" (D. App. 89b). (Italics ours.)

In the light of this record and the admonition of the District Court, it is clear that petitioner had ample time to, and in fact did, fully present his case in opposition to respondent's motion for summary judgment.

CONCLUSION

Since this case has no importance beyond the immediate facts and parties involved therein and was decided by the proper application of well established principles of law to a specific set of facts, the petition presents no reason whatsoever for review on writ of certiorari and should be denied.

Respectfully submitted,

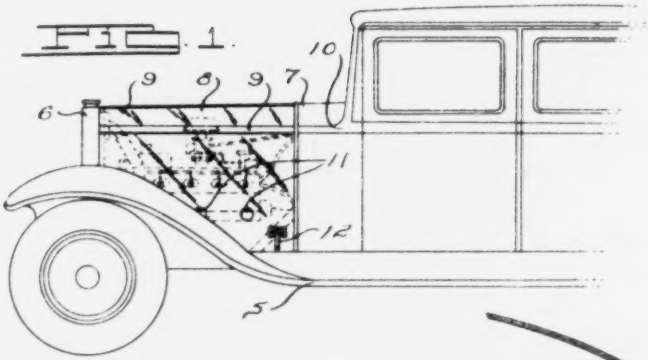
GEORGE L. DeMOTT,
ARTHUR RAISCH,
Counsel for Respondent.

May 30, 1933. G. H. BOBERTZ, JR., ET AL 1,911,600

AUTOMOBILE HOOD

Filed Nov. 22, 1932

Fig. 1.



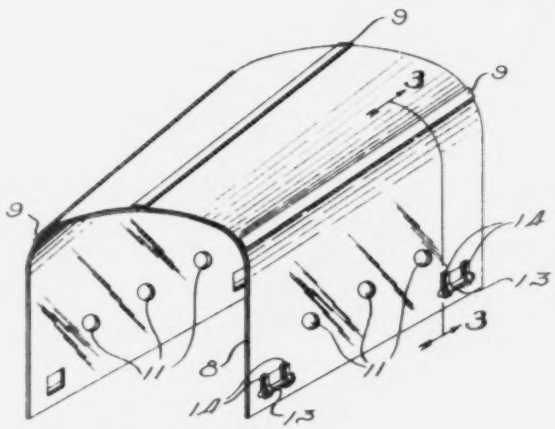


Fig. 2.

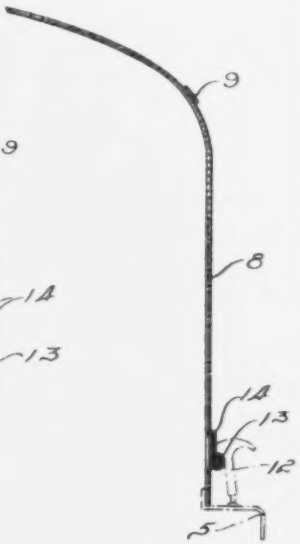


Fig. 3.

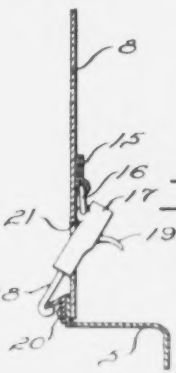
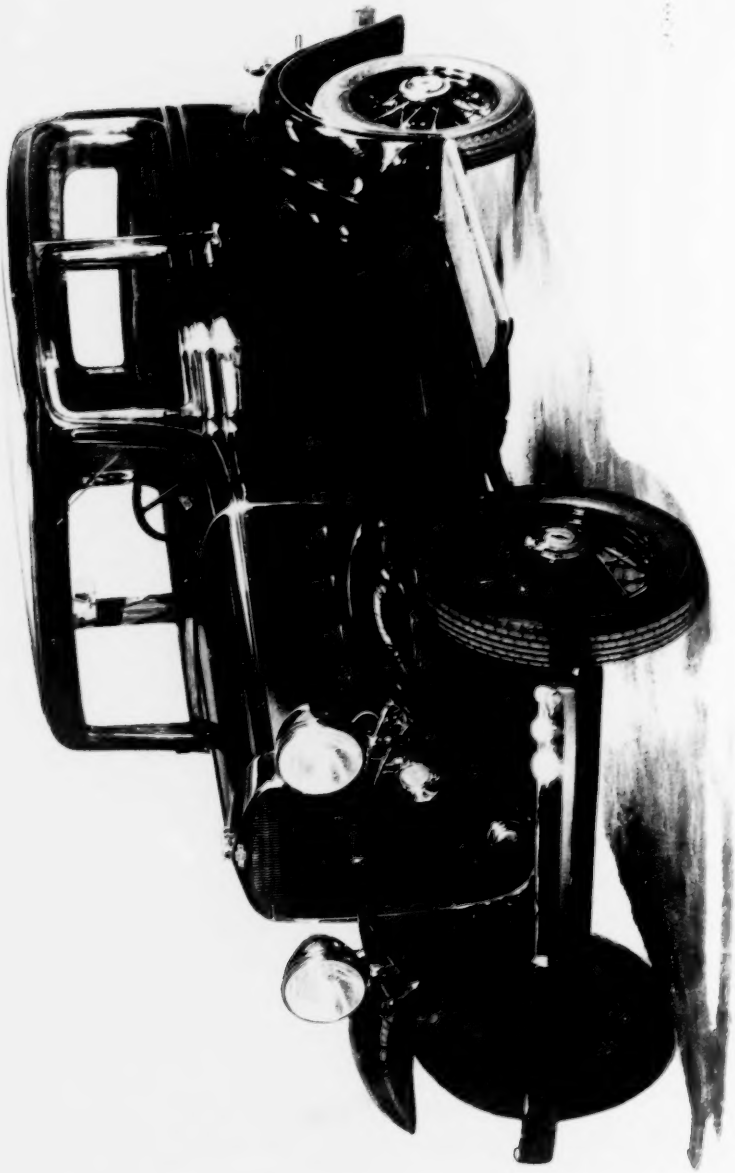
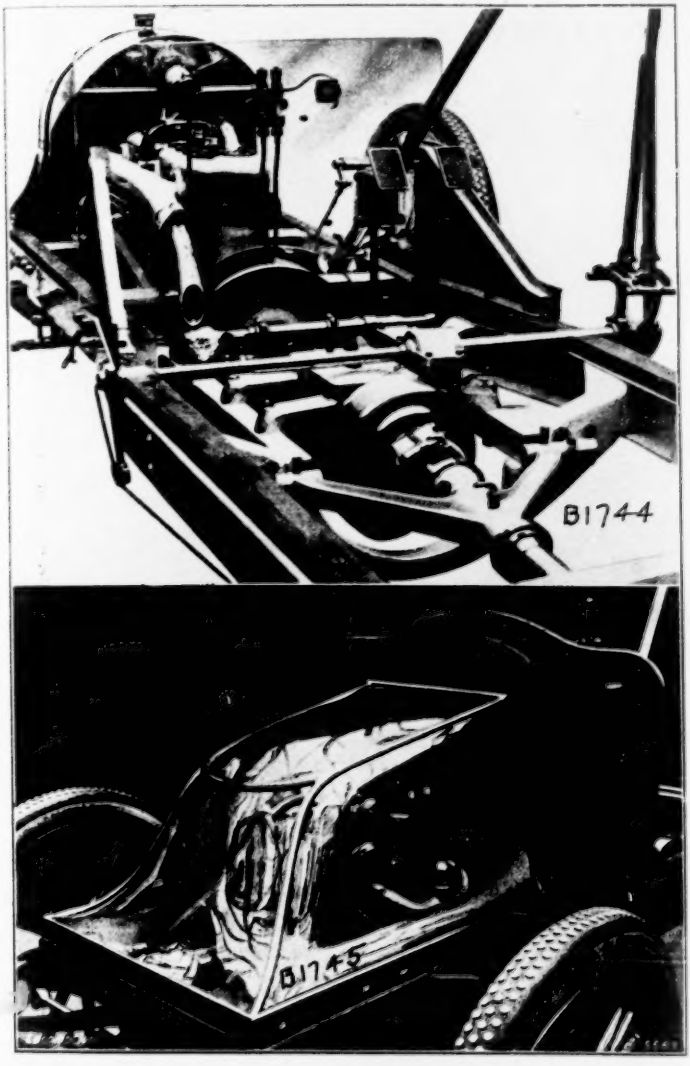


Fig. 4.

INVENTORS.
Timothy J. La Fontaine,
Gustav H. Bobertz, Jr.
BY Clifton M. Smith
ATTORNEY





PRÉSENTATION ORIGINALE D'UN MÉCANISME. — *En haut*, châssis Grégoire muni d'un garde-crotte en verre. — *En bas*, châssis Bayard-Clément avec capot en verre.

Bayard-Clement chassis with glass hood

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IN THE

Supreme Court of the United States

October Term, 1956

No. 988 85

GUSTAV H. BOBERTZ, JR., *Petitioner,*

v.

GENERAL MOTORS CORPORATION, *Respondent.*

REPLY BRIEF FOR THE PETITIONER IN SUPPORT OF HIS PETITION FOR WRIT OF CERTIORARI

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IN THE

Supreme Court of the United States

October Term, 1956

No. 938

GUSTAV H. BOBERTZ, JR., *Petitioner,*

v.

GENERAL MOTORS CORPORATION, *Respondent.*

REPLY BRIEF FOR THE PETITIONER IN SUPPORT OF HIS PETITION FOR WRIT OF CERTIORARI

CHARACTER OF THE CASE

This case presents a conflict between two United States Circuit Courts of Appeal on the question of procedural due process in adjudication of patent causes. The presence of such conflict is in no way diminished by the fact that the conflicting decisions on such question were not rendered on the same patent.

There are now two United States Circuit Courts of Appeal, the Sixth Circuit and the Ninth Circuit, having opposite policies and procedures with respect to adjudicating validity of patents. The Court of

Appeals for the Sixth Circuit authorizes adjudication of validity of patents on the prior art without trial after consideration of documents in chambers, while the Court of Appeals for the Ninth Circuit holds that any tendency to abolish trial in patent cases for consideration of documents *in camera* should be curbed. This conflict has serious public consequences and should be resolved.

Allegations of Respondent's Brief (p. 6) That It Supported Its Motion for Summary Judgment by "Self-proving Documents Which Have Not Been, and Could Not Be, Contradicted In Any Manner by the Petitioner" Are in Conflict With the Record.

In justification of such sweeping statement to this Court, respondent's brief gives a list of such supporting evidence, including, in the main, six (6) items of alleged anticipating prior art and three (3) supporting affidavits of its employees, which affidavits are expressly described as "uncontroverted" (p. 5).

(a)

The "uncontroverted" affidavits of respondent's employees Thorpe and Hirshman, presenting as exhibits a large number of photographs alleging them to be "truly showing" the subject-matter (D.R. 55b),* were controverted by the opposing affidavit of the petitioner Gustav H. Bobertz, Jr. (Pl. R. 53a-54a) as follows:

> "4. I have examined affidavits of Stanley C. Thorpe and George Hirshman, and I find that photographs of the accused hood identified as

* The abbreviations "Pl.R." and "D.R." are used herein to designate plaintiff-petitioner's and defendant-respondent's appendices, respectively.

'Hirshman Affidavit Exhibits 8, 9, and 10' are either accidentally or intentionally taken after certain constructional elements material to the issues of the case and originally existing in the hood had disappeared through deformation of the plastic because of usage or the said photographs identified as 'Hirshman Affidavit Exhibits 8, 9, and 10' were accidentally or intentionally taken with such illumination exposures and at such angles as to make the configuration of the hood and particularly of some essential structural elements thereof covered by the claims, either as completely absent or not clearly appearing; that Hirshman affidavit Exhibit 11 *represented in said affidavit as a photograph truly showing* the transparent plastic hood mounted upon the 1949 Oldsmobile, *does not, in fact, represent truly the same, . . .* " (Italics ours).

(b)

Each and every item of the prior art relied on by the respondent in its motion for summary judgment was contradicted by the opposing affidavit of petitioner's expert Tjaarda, an automobile designer and stylist of world renown, who, at the beginning of his career, was employed by the respondent General Motors Corporation "in charge of design of the Art and Color Section". Tjaarda stated in his opposing affidavit (Pl.R. 57a):

"10. I have also carefully examined the disclosures contained in the documents enumerated in page 3 under the headings '(1), (2), (3), (4), and (5)' of the document entitled 'Defendant's Motion for Summary Judgment on Ground of Non-infringement and Invalidity' in the present litigation and find that *none of said disclosures* teaches even a skilled body designer how to produce a display engine hood disclosed and claimed

in the above identified U. S. Patent No. 1,911,600, and that these documents show either automobiles with their original steel hoods having windows provided in them, which *do not have* the same advantages as the all plastic hood disclosed in the patent; or disclose *covers used for engines on chassis displays* which need not complete or carry out the lines of the body design and *do not solve the problems solved in displaying complete automobiles by the hood disclosed by the patent in suit;* U. S. Patent No. 1,045,152 to Kelsey showing a flying machine with transparent hatch cover intended to cover the pilot and not the engine, is equivalent of a door, *does not* relate to displaying automobiles, and is wholly impertinent to the issues of this case; the German patent No. 379,379 to Rumpler does not relate to displaying automobiles, and whatever engine hood is referred to in said patent *does not* have the combination of structural elements disclosed and enumerated in the U. S. Patent No. 1,911,600 in suit; said patent merely states the problem of use of plastics in automobile bodies but wholly fails to give any solution for it, and has no more useful teaching than a statement 'make entire Empire State Building out of plastic' would have. In studying defendant's submitted translation of said German patent No. 379,379 I also notice certain material inaccuracies in translation." (Italics ours)

With respect to the file wrapper of the patent in suit and the prior art cited against petitioner's application during prosecution thereof, Tjaarda's affidavit stated (Pl.R. 57a):

"9. I have carefully studied the U. S. Patent No. 1,911,600 issued May 30, 1933, for Automobile Hood to Gustav H. Bobertz, Jr. and Timothy J. LaFontaine, as well as a complete certified copy

of the record of prosecution of said patent in the U. S. Patent Office, together with the references cited against said application during prosecution thereof; as a result of said study, I find that none of the references cited against said application disclosed an automobile hood comprising in combination the constructional elements disclosed in this patent enumerated by the claims of said patent, or equivalents of such elements."

Respondent's physical exhibit—accused display hood—was objected to as improper and misleading in both of the opposing affidavits (Pl.R. 52a and 58a). Respondent also presented a sample of conventional steel hood improperly stripped of many of its parts, thus leading the Court into the mistaken belief that this was a case of mere "substitution of materials". Neither hood was operative for the purposes of the other.

(c)

The very photograph on p. 3b of respondent's brief to this Court was contradicted by the opposing affidavit of Tjaarda as quoted above and is an example of a transparent engine cover wholly inoperative for the purposes of the invention.

This cover has glass panels not only at top and both sides but also in *front*. Therefore, because of the operation of the *laws of physics governing transparency and reflection*, this cover will always have one of its panels transparent and *can never give the effect of total non-transparency which is necessary to complete the body lines of the exhibited automobile*, as attained by the petitioner's hood at certain desired angles of observation.

Petitioner could prove this physical phenomenon by demonstrating a simple physical exhibit.

Petitioner's answer to respondent's motion for summary judgment denied every material allegation of fact made by the respondent, and the facts material to the issue of validity of the patent in suit were in sharp dispute.

CONCLUSION

Because of the rapid concentration of control taking place in the automobile industry, invalidation without trial of patents of suppliers manufacturing for that industry may greatly accelerate the process of such concentration.

Invalidating patents of these suppliers may not have the effect of releasing the patented subject-matter for the free use of the public. Because of the extremely limited number of outlets open for the products of such manufacturers, such invalidations may operate in many cases for the sole benefit of a single concern and enable it, in effect, to derive high profits from the investment of capital made by others.

The uncertainty as to whether or not such a manufacturer-supplier would be entitled to defend validity of his patent by evidence at a trial should the respondent charge that the patent covers a "simple" invention, may operate to prevent resort to courts by such manufacturer-suppliers for defense of their patent rights, and may put the respondent in a position of practical control of a large aggregate investment made by thousands of small and medium size manufacturers, without the necessity of owning any of their corporate stock.

The respondent was, in effect, rapidly moving toward acquiring substantially similar control over its dealers by holding the power of cancelling dealers' franchises virtually at will. At the outset of the public consideration of that particular matter, the respondent similarly attempted to brush it aside as the grumblings of one dissatisfied dealer not worthy of anyone's attention.

The reasons for granting this petition are of public importance, and the petition should be granted.

Respectfully submitted,

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AUG 6 1956
JOHN T. FEY, Clerk

IN THE

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OCTOBER TERM, 1956

No. 85

GUSTAV H. BOBERTZ, JR.,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent

REPLY BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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REPLY BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

Petitioner contends that the decision in the instant case by the United States Court of Appeals for the Sixth Circuit conflicts with the decision of the United States Court of Appeals for the Ninth Circuit in *Hycon Manufacturing Company v. H. Koch & Sons,* 219 Fed. (2d) 353. In the Hycon case the District Court granted a motion for summary judgment finding the patent in suit *valid* but was reversed by the Court of Appeals on the ground that sub-

stantial issues of fact remained in the case. The Court stated at 219 Fed. (2d) page 355

> "An indispensable prerequisite to such a judgment is the absence of a material question of fact."

In the instant case the Court of Appeals affirmed the District Court and held the Bobertz patent in suit 1,911,600 *invalid* for want of invention, 228 Fed. (2d) at 101. The Court of Appeals stated, 228 Fed. (2d) 94, at 100

> "Where there was no genuine issue of material fact presented, this court has affirmed a summary judgment for the defendant in a patent case. *Lincoln Electric Co. v. Linde Air Products Co.*, 6 Cir., 171 F. 2d 223."

That this same rule of law is followed by the Court of Appeals for the Ninth Circuit, see *Leishman v. Radio Condenser Co.*, 167 Fed. (2d) 890; *Park-In-Theatres, Inc. v. Perkins*, 190 Fed. (2d) 137.

In the instant case and in the Hycon case the Courts of Appeals for both the Sixth and Ninth Circuits followed the provision of Rule 56 (c) that a motion for summary judgment should be granted

> "* * * if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact * * *."

In the Hycon case the Court found a genuine issue as to material facts whereas in the instant case both the District Court and the Court of Appeals found no genuine issue as to any material fact. Thus, it is evident that there is no conflict in the decisions of the Courts of Appeals for the Sixth and Ninth Circuits.

Long before the adoption of the Federal Rules of Civil Procedure this Court approved summary judgment in patent cases holding the patent in suit void on demurrer where the patent was manifestly void, *Richards v. Chase Elevator Co.,* 158 U. S. 299, 15 S. Ct. 831, 39 Law Ed. 991; *Risdon Iron & Locomotive Works v. Medart,* 158 U. S. 68, 15 S. Ct. 745, 39 Law Ed. 899.

Petitioner and respondent are in agreement that the configuration or form of the accused hood is substantially as shown in petitioner's own Exhibits F and G found at pages 63a and 64a of plaintiff's (Petitioner's) Appendix. Because there is no disagreement as to the form or configuration of respondent's plastic hood, therefore, whether or not the respondent's physical exhibit of the accused display hood is a fair sample and the photographs thereof (Hirshman affidavit Exhibits 8, 9, 10, 11) truly represent the same, are not material facts. Since the Court of Appeals affirmed the District Court on the ground that the Bobertz patent is *invalid* and did not decide the question of infringement (228 Fed. (2d) at 101), respondent's accused hood and the photographs thereof were not at all necessary or material to this decision.

On pages 3, 4 and 5 of his reply brief petitioner quotes from the affidavit of Tjaarda which sets forth Tjaarda's conclusions, opinions and arguments with respect to the prior art relied upon by respondent. Since Tjaarda's affidavit does not set forth facts, it does not conform to Rule 56(e).

The province of an expert was clearly delineated by Judge Learned Hand in *Kohn v. Eimer,* 265 Fed. 900, 902 (C. A. 2) in the following words:

> "At the outset the appellant challenges our right to examine the prior art patents at all, because the

> appellee called no expert at the trial to explain them. *Waterman v. Shipman*, 55 F. 982, 987, 5 C. C. A. 371. We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended, as the appellant has misapprehended it here. Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is inevitably a burdensome impertinence."

Because of the extreme simplicity of the transparent automobile hood which is the subject matter of this suit and since the prior art patents and publications relied upon by respondent can be easily comprehended even by a lay person, it is obvious that there is no need for expert testimony in this case and that the Court below properly decided that the patent in suit was invalid as a matter of law, *Market Street Cable Railway Co. v. Rowley*, 155 U. S. 621, 625, 39 Law Ed. 284.

Respectfully submitted,

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